

REMARKS

Claims 1, 3-5 and 8-20 are pending.

Claims 1, 8 and 10 are independent claims.

Foreign Priority And Information Disclosure Statement

The indication that the foreign priority document has been received and placed in the file is noted.

The indication that the Information Disclosure Statement of December 27, 2000 was considered is noted.

Reply to the Objections

In section three (3) of the Office Action claim 16 was objected. An appropriate correction was required. Claim 16 has been amended. Also claim 19 has also been amended to cure its dependency.

Entry of the Amendment

The above amendment should be entered because it does not raise any new issues and reduces issues for appeal.

Reply to Rejections

First rejection

Claims 1, 3-5, 8-9 and 16 were rejected under 35 U.S.C. 102(b) as being anticipated by Goldhaber (US Patent 5,794,210). This rejection is traversed.

In claim 1 there is the following structure which at least is not shown in the reference either specifically or inherently.

...electronic advertisement storage control means for storing said electronic advertisement received by said electronic advertisement receiving means, when said identifying information does not match said identifying information of each of said at least one electronic advertisement stored in said electronic advertisement storing means.

It is understood that in treating the reference Goldhaber et al. the Office Action has relied on column 16, lines 25-40 with the assertion that this shows what has been claimed in the last paragraph of claim 1 (amended). But column 16, lines 25-40 states as follows:

Brokerage server to look for matches between its consumer's interest profile 124 and indexed demographic information corresponding to the ads maintained by the attention brokerage server (Fig. 11A, block 184). The software agent 110 and/or the attention brokerage serve 106 may remove from the list of matches all ads that the consumer has already viewed (or has viewed within a particular time frame) (Fig. 11A, block 186). The software agent 100 may then return to the consumer's computer 104 with a file of thumbnail file on the consumer's computer 104 along with CyberCoin icons 62. Selecting the associated CyberCoin icon 62 initiates an interaction between the consumer's computer 104 and the attention brokerage server 106 that stores the matching ad (see below). (Emphasis Added)

Claim 16 is now dependent on claim 15 and will be noted below in the response to the rejection to claim 15.

Clearly what is shown in the reference is that the ads that the viewer has already seen are not listed. But amended claim 1 is quite different because the electronic advertising storage controls means stores only those identifying information that does not match identifying information that has previously been stored.

Note in the disclosure of Goldhaber et al. there is no control means (noted above) that performs the function that has been claimed. For example in Goldhaber et al. the advertisement can still be stored after a particular time frame. For example, if after 5 minutes the ad appears again, it is again stored in Goldhaber et al. even though it had been previously stored. But this is not the function that has been claimed. Furthermore, while it may be possible or probable that Goldhaber et al can function in the manner claimed a rejection under 35 U.S.C. 102 cannot be based on possibility or probability. See Continental Can Co. USA, Inc. v Monsanto, 20 USPQ 2d, 1746, 1749, 1750 (Fed. Circ. 1991) which was explained in the last Reply at the bottom of page 15.

Also, the features of claim 4 are not disclosed in Goldhaber, et al. cited in the Office Action.

With respect to independent claim 8, this claim includes the structure of its previous base and intervening claims (claims 6 and 7). It is submitted that this structure is not shown either specifically or inherently in the reference applied. In fact, it does not appear from the Office Action that the Office Action has specifically identified wherein the reference this structure is disclosed.

With respect to claim 9, which is dependent on claim 8, this claim is considered patentable for at least the same reasons as its base claim.

In the Office Action the Examiner states on page 6, Section 7 the following:

Also, the Examiner notes that while specific references were made to the prior art, it is actually also the prior art in its entirety and the combination of the prior art in its entirety that is being referred to.

This statement is not understood especially in a rejection under 35 U.S.C. 102. See *Ex parte Levy* 17, USPQ 2d 1461, 1462 (BPAI 1990) (cited in the MPEP) wherein the board stated as follows:

The factual determination of the anticipation requires that the disclosure in a single reference of every element of the claimed invention...moreover it is encumbant upon the Examiner to identify each and every facet of the claimed invention that is disclosed in the applied reference.

Also in the Office Action the Examiner stated "note that the Offers to sell something, cited (col 20, lines 10-26) above are functionally equivalent to an advertisement" Functionally equivalent relates to a rejection under 35 U.S.C. 103 not 35 U.S.C. 102. Also an advertisement in fact and law is not the same thing as an offer to sell. An advertisement is a request for a buyer to make an offer and is not an offer per se.

For the reasons set forth above the Examiner is requested to reconsider and withdraw the rejection of the claims under 35 U.S.C. 102.

Second rejection

Claims 10-15 were rejected under 35 U.S.C 103(a) as being unpatentable over Goldhaber et al (US Patent 5,794,210), this rejection is traversed. Note claim 16 which is a dependent claim now depends on claim 15.

It is the Examiner's position that this would have been obvious for the reasons set forth in the rejection, but there is no evidence of this other than speculation in the Office Action which cannot be considered as viable evidence under 35 USC §103.

It appears what the Examiner's position is that one skilled in the art would be capable of doing what the Applicant has done. But capability does not equate to obviousness. *Ex parte Levengood* 28, USPQ 2d 1300 ((BPAI 1993) (also cited in the MPEP wherein the board stated as follows))

At best, the Examiner's comments regarding obviousness amount to an assertion that one of ordinary skill in the relevant art would have been able to arrive at the Appellants invention because he had the necessary skills to carry out the requisite process. This is an inappropriate standard for obviousness. (Emphasis Added)

Also it would appear the Office Action may be asserting that this is basic knowledge to one skilled in the art. This also is

not evidence. See *In re Zurko* 59USPQ2d 1693, 1697 (Fed. Cir. 2001). Also cited in the MPEP wherein the court stated as follows:

We cannot accept these findings by the Board. This assessment of basic knowledge... was not based on any evidence in record, and, therefore, lack substantial evidence support.

A feature of the present invention in the context claimed is that a user is able to gain benefits from an advertiser in return for confirmation of distributed add information. This is a result that must be given significance in a rejection under 35 USC 103. See The Gillette Co. v. S.C. Johnson & Son, Inc., 16 USPQ2d 1923, 1928 (Fed. Cir. 1990) wherein the court stated as follows:

An analysis of obviousness of a claim combination must include consideration of the result achieved by the combination. As we explained in *Inter Connect Planning Corp. v. Feil*, 774 Fed. Cir. 1132, 1143, 227 USPQ 543, 551 (Fed. Cir. 1985) [cited in the MPEP].

For the reasons set forth above, the Examiner is requested to reconsider and withdraw the rejection of the claims under 35 USC §103.

Third rejection

Claim 17-20 were rejected under 35 U.S.C. 103(a) as being unpatentable over Goldhaber et al. (US Patent 5,794,210) in view of Sharony et al. (US Patent 5,742,593). This rejection is traversed.

The addition of Sharony et al. does not cure the innate deficiency of a rejection based on Goldhaber et al.

The features of claims 17-20 are supported by the description on page 14, lines 19-31 and page 27, lines 14-25 of the specification.

In summary, when a user having received an electronic advertisement through a certain communication line is going to enjoy benefits the electronic advertisement offers, the user informs, through a different communication line (e.g. short-haul radio communication line), namely a communication line different from the communication line through which the electronic advertisement is received, the advertiser of the user's intention to receive the benefits. Then, if the user receives the electronic advertisement through a mobile phone, the user can visit the shop of the advertiser to present, through a communication line different from the communication line of the mobile phone used for receiving the advertisement, the information that the advertisement has actually been presented to the user. In return for this presentation of the information, the user can receive the benefits from the advertiser. The present invention thus does not need such a complicated management of the user profile as disclosed in the cited references. No reference cited discloses or suggests the above-described features of the present invention.

Also the results must be considered at arriving at the conclusion of obviousness, which apparently has not been done. See the comments as to result set forth in the reply to the second rejection. Most combination claims are based on known elements but it is the combination that counts. See Rubben Condenser Co. v Copland Refrigeration Corporation, 85 Fed 2d 5307 (Ca 1936)

For the reasons set forth above the Examiner is requested to reconsider and withdraw the rejection under 35 U.S.C. 103

Additional Art

Additional art was cited but as this art has not been applied no further comments are considered necessary.

Conclusion

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Elliot A. Goldberg (Reg. No. 33,347) at the telephone number of the undersigned below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees

required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

Respectfully submitted,

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